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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/763,883 | 04/16/2001 | Jaakko Rajaniemi | P277191 | 3470 |

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EXAMINER

DAO, MINH D

ART UNIT PAPER NUMBER

2682

DATE MAILED: 01/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

DN

Office Action Summary

Application No.

09/763,883

Applicant(s)

RAJANIEMI ET AL.

Examiner

MINH D DAO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-30 is/are allowed.
- 6) ☒ Claim(s) 31 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 31 is rejected under 35 U.S.C. 102(e) as being anticipated by Huusko et al. (US Patent 6,397,065).

Regarding claim 31, Huusko teaches A network controller for supporting a terminal in a telecommunications system including a core network (See Fig. 3, item CN) and an access network (See Fig. 3, item RAN), the network controller comprising: a reporting module (Col. 8, lines 18-27) configured to report location information of the terminal to the core network; and a transforming module configured to transform the location information into transformed location information, wherein the transforming module transforms the location information into transformed location information prior to the reporting module reporting the location information of the terminal to the core network (Col. 8, lines 28-67; Col. 9, lines 1-4).

Allowable Subject Matter

3. Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 32, Huusko et al. (US Patent 6,397,065) teaches all limitations in claim 31. However, Huusko fails to teach that the network controller of claim 31, wherein the core network is configured to determine the terminal location and the access network includes a drift network controller configured to maintain a connection with the terminal, wherein the network controller is configured to act, at least temporarily, as a serving network controller of the terminal in the access network, and to report the terminal location to the core network, and wherein the network controller is configured to receive location information from the drift network controller and to report the location information to the core network for determining the terminal location. As specified in the claim.

4. Claims 1-30 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claim 1, reference Huusko (US Patent 6,397,065) fails to teach that the access network including a first network controller configured to at least temporarily act as a serving network controller of the terminal and to report a location of the terminal to the core network, and a second network controller configured to at least temporarily act as a drift network controller of the terminal

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and to maintain a connection with the terminal, the method comprising:
transmitting location information of the terminal to the core network based on a first set of predetermined criteria, the location information being indicative of the terminal location; transmitting location information to the second network controller in response to the first set of predetermined criteria; transmitting the location information to the first network controller; reporting the location information to the core network; transforming the location information into transformed location information based on a second set of predetermined criteria; and transmitting the transformed information to the core network in response to the second set of predetermined criteria. As specified in the claim.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Widegren et al. (US Patent 6,374,112) discloses Flexible Radio Access And Resource Allocation In a Universal Mobile Telephone System.

b. Tayloe et al. (US Patent 5,826,188) discloses Method And Apparatus For Handing Off Calls Between Different Network.

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c. Naghian (US 2002/0086682) discloses Method For Positioning A Mobile Station.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D DAO whose telephone number is 703-305-5589. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN C CHIN can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Minh Dao
Examiner
Art Unit 2682
January 2, 2004 *mmj*


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

1/9/04